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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,679	11/21/2006	Bernhard Mussig	101769-351 KGB	3541

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NORRIS, MCLAUGHLIN & MARCUS, PA
875 THIRD AVENUE
18TH FLOOR
NEW YORK, NY 10022

EXAMINER	
NGUYEN, CHAU N	

ART UNIT	PAPER NUMBER
2831	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/573,679	MUSSIG, BERNHARD	
	Examiner	Art Unit	
	Chau N. Nguyen	2831	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 November 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

(a) TITLE OF THE INVENTION.
(b) CROSS-REFERENCE TO RELATED APPLICATIONS.
(c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
(d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
(e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
(f) BACKGROUND OF THE INVENTION.
    (1) Field of the Invention.
    (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
(g) BRIEF SUMMARY OF THE INVENTION.
(h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
(i) DETAILED DESCRIPTION OF THE INVENTION.
(j) CLAIM OR CLAIMS (commencing on a separate sheet).
(k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakagawa et al. (2001/0031355) in view of Aritake (4,513,028).

Nakagawa et al. discloses a halogen-free, phosphorus-free, flame-resistant wrapping foil of polyolefin, comprising carbon black and metal hydroxide which aluminum hydroxide ([0046]). Nakagawa et al. also discloses the metal hydroxide content being more than 120 phr ([0051]), the carbon black fraction being at least 5 phr ([0052]), the foil comprising at least one polypropylene having flexural modulus of less than 900 Mpa ([0040]), the foil having a thickness of 30 to 180 μm ([0054]), the foil comprising polypropylene and also EP or EPDM copolymer, the

foil having a layer of adhesive applied directly or indirectly on one side thereof, the adhesive being joined to the surface of the foil by means of a flame or corona pretreatment, and the foil being used for bundling wires or cables. Nakagawa et al. does not disclose the adhesive layer being a layer of solvent-free pressure-sensitive adhesive dispersion based on polyacrylate. Aritake discloses a wrapping foil comprising a layer of adhesive which is a layer of solvent-free pressure sensitive adhesive dispersion based on polyacrylate (col. 6, lines 66-68; col. 7, lines 1-28). It would have been obvious to one skilled in the art to use the adhesive layer as taught by Aritake for the adhesive layer of Nakagawa et al. since it is taught by Nakagawa et al. that any adhesive ([0057]) can be used with the foil and the adhesive taught by Aritake can be easily applied to a substrate and provides an adequate adhesion property (Aritake, col. 6, lines 46-53). It is noticed that the claimed characteristics and properties of the foil are inherent from the modified foil of Nakagawa et al. since it comprises structure and material as claimed.

It would also have been obvious to one skilled in the art to choose suitable amount, the bond strength, and the unwind force for the adhesive layer of Nagakawa et al. to meet the specific use of the resulting foil since it has been held that where the general conditions of a claim are disclosed in the prior art,

discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Re claims 11-16, it would have been obvious to one skilled in the art to use the modified wrapping foil of Nakagawa et al. to wrap a cable bloom or a field coil in a picture tube since the wrapping foil of Nakagawa et al. has superior in flexibility, resistance to thermal deformation, flame resistance and resistance to whitening. In addition, it has been held that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d

937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-5, 7-10, and 14-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 10/573244. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-5 of said copending application disclose the invention as claimed. Re claim 2, it would have been obvious to one skilled in the art to use aluminum hydroxide as the metal hydroxide for the foil of said copending application since aluminum hydroxide is well-known in the art for being used as flame retardant filler.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/529092. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-12 of

said copending application disclose the invention as claimed. Re claim 2, it would have been obvious to one skilled in the art to use aluminum hydroxide as the metal hydroxide for the foil of said copending application since aluminum hydroxide is well-known in the art for being used as flame retardant filler.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 10/574028. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-11 of said copending application disclose the invention as claimed. Re claim 2, it would have been obvious to one skilled in the art to use aluminum hydroxide as the metal hydroxide for the foil of said copending application since aluminum hydroxide is well-known in the art for being used as flame retardant filler.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 10/573399. Although the conflicting claims are not

identical, they are not patentably distinct from each other because claims 1-13 of said copending application disclose the invention as claimed. Re claim 2, it would have been obvious to one skilled in the art to use aluminum hydroxide as the flame retardant for the foil of said copending application since aluminum hydroxide is well-known in the art for being used as flame retardant filler.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

8. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Applicant alleges that the examiner provides no reason why persons skilled in the art should choose Aritake' s adhesive from all the known adhesive systems as the system of choice for modifying Nakagawa' s system. The Examiner has not pointed to a single advantage that Aritake' s adhesive would have been expected to have over Nakagawa's adhesive that would arguably have provided persons skilled in the art with adequate motivation to make the substitution the Examiner proposes. Examiner disagrees. The fact that Nakagawa et al. suggests that any adhesive such as rubber type, hot melt type, acrylic type and emulsion type

adhesives can be used ([0057]) and the fact that Aritake teaches that the use of acrylic adhesive material without a solvent provides an adhesive tape having a good quality (col. 7, lines 43-47), one skilled in the art would have motivated to use the solvent free acrylic adhesive material taught by Aritake for the adhesive material of Nakagawa et al. to provide a good quality adhesive tape.

As to the unexpected results, such as not brittle after hours of operation, as discovered by the applicant, the modified adhesive tape of Nakagawa et al. would provide such results since it comprises structure and material as claimed. It has been held that the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau N. Nguyen whose telephone number is 571-272-1980. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutiérrez can be reached on 571-272-2800 ext

31. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chau N Nguyen/
Chau N Nguyen
Primary Examiner
Art Unit 2831